

C3 (f) the amino acid sequence of] at least 30 contiguous amino acid residues of SEQ ID NO:2;
and
(d) [(g) a fragment having] at least 30 contiguous amino acid residues of the polypeptide encoded by the human cDNA in ATCC Deposit No. [97132] 97165;

C4 77. (once amended) The polypeptide of claim [63] (60), wherein said polypeptide [has] comprises at least 50 contiguous amino acid residues of SEQ ID NO:2.

78. (once amended) The polypeptide of claim [63] (60), wherein said polypeptide [has] comprises at least 50 contiguous amino acid residues of the polypeptide encoded by the human cDNA in ATCC Deposit No. [97132] 97165.

Remarks

Claims 57-61, 71, 74, and 77-78 will be pending upon entry of this amendment. Reconsideration of the objections and rejections made in the Official action is respectfully requested.

The specification was amended to include a priority statement, to update the address of the ATCC and to correct a misnumbered Example.

Claims 57, 77, and 78 have been amended to correct the ATCC Deposit No., i.e. No. 97132 was corrected to No. 97165. As the examiner points out, claims allowed in the parent application US Serial No. 08/483,584 recite ATCC No. 97165. A copy of the ATCC Deposit Receipt for Accession No. 97165 (Applicants Docket No. PF206) is submitted herewith for the convenience of the Examiner.

No new matter has been added.

I. Miscellaneous

a. The Restriction Requirement

According to the summary of the Office Action mailed 02/1/99, claims 39-42 and 45-47 were withdrawn from consideration by the Examiner. However, the Examiner indicated that claims 39-42, 45-47, and 57-78 are subject to a restriction or an election requirement despite the lack of reference to such a requirement elsewhere within the action.

Applicants are unclear as to the status of this requirement, but are treating the restriction as if it were made final. Accordingly, applicants have canceled claims 39-42 and 45-47. It is believed that all remaining claims are drawn to Group I.

b. Public Access to ATCC Deposit No. 97165

Applicants representative hereby gives the following assurance by signature below:

Human Genome Sciences, Inc., an assignee of the present application, has deposited biological material under the terms of the Budapest Treaty on the International Recognition of the Deposit of

Micro-organisms for the Purposes of Patent Procedure with the following International Depository Authority: American Type Culture Collection (ATCC), 10801 University Boulevard, Manassas, Virginia 20110-2209. These deposits comprise cDNA sequences encoding Endothelial-Monocyte Activating Polypeptide III (EMAP III). The deposit for EMAP III was made on May 26, 1995, and given ATCC Accession Numbers 97165. In accordance with MPEP 2410.01 and 37 C.F.R. § 1.808, assurance is hereby given that all restrictions on the availability to the public of ATCC Accession Number 97165 will be irrevocably removed upon the grant of a patent based on the captioned application, except as permitted under 37 C.F.R. § 1.808(b).

A copy of the ATCC Deposit receipt for Accession Number 97165 is enclosed herewith.

II. Rejections under 35 U.S.C. § 112, first paragraph

a. The Examiner has rejected claims 57, 59, 60, 62, 64, 65, 67, 68, and 70-76, under 35 U.S.C. § 112, first paragraph, for lack of written description. More particularly, the Examiner alleges:

the claims recite ATCC Deposit No. 97132. This ATCC number is never mentioned in the specification. It appears that the claims submitted in Paper No. 2 (18 November 1998), now canceled, and Paper No. 6 (12 November 1998), pending, contain a typographical error wherein ATCC deposit No. 97165 was intended.

Applicants have carefully reviewed their records and agree with the Examiners' assertion that ATCC Deposit No. 97132 represents a typographical error and have amended claims 57 and 78 to reflect the correct ATCC Deposit No., No. 97165.

b. The Examiner has further rejected claims 65-70, 72, 73, 75, and 76, under 35 U.S.C. § 112, first paragraph, as such claims which are drawn to fragments and variants that retain a biological activity allegedly lack written description.

Applicants disagree, however, Applicants have canceled the rejected claims rendering the rejection moot. Applicants expressly assert that claims 65-70, 72, 73, 75, and 76, were canceled for the sole purpose of facilitating prosecution, and not in an effort to overcome any 35 U.S.C. § 112, first paragraph rejections. Applicants reserve the right to prosecute these claims in related applications.

c. The examiner has rejected claims 57-77 under 35 U.S.C. § 112, first paragraph, as the specification allegedly fails to enable variant EMAP III polypeptides which retain the activity of the protein shown as residues 1-168 of SEQ ID NO:2.

Applicants disagree. Nonetheless, claims 57-77 were either amended or canceled to remove the offensive language for the sole purpose of facilitating prosecution, and not in an effort to overcome any 35 U.S.C. § 112, first paragraph rejections. Applicants reserve the right to prosecute these claims in related applications.

In view of the amendments and comments above, Applicants believe that the rejections under 35 U.S.C. § 112, first paragraph, have been overcome and respectfully request that the rejections be withdrawn.

III. Rejection Under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 65-67, 72, and 75 under 35 U.S.C. § 112, second paragraph, as "conservative substitution" is allegedly an indefinite term.

Applicants disagree. However, solely in the interest of expediting prosecution, Applicants have canceled the rejected claims. Applicants expressly assert that these claims were canceled for the sole purpose of facilitating prosecution, and not in an effort to overcome this 35 U.S.C. § 112, second paragraph rejection. Applicants reserve the right to prosecute these claims in related applications.

Applicants assert that in view of the above amendments and remarks, the Examiner's rejection under 35 U.S.C. § 112, second paragraph, have been obviated or overcome and should be withdrawn.

IV. Rejection Under 35 U.S.C. § 102

The examiner has rejected claims 68-70, 73, and 76 under 35 U.S.C. 102, as being anticipated in light of Stern et al., U.S. Patent 5,641,867.

Applicants disagree. However, solely in the interest of expediting prosecution, Applicants have canceled the rejected claims. Applicants expressly assert that these claims were canceled for the sole purpose of facilitating prosecution, and not in an effort to overcome any 35 U.S.C. § 102 rejection. Applicants reserve the right to prosecute these claims in related applications.

Applicants assert that in view of the above amendments and remarks, the Examiner's rejection under 35 U.S.C. § 102, have been obviated or overcome and should be withdrawn.

V. Conclusion

Applicants respectfully request that the amendments and remarks of the present response be entered and made of record in the present application. The application is believed to be in condition for allowance. Early notice to that effect is earnestly solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution, the undersigned can be reached at the telephone number indicated below. If a fee is required in connection with this paper, please charge Deposit Account No. 08-3425 for the appropriate amount.

Date: 3/31/99

Respectfully submitted



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AAB/mbp



American Type Culture Collection

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BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE

INTERNATIONAL FORM

RECEIPT IN THE CASE OF AN ORIGINAL DEPOSIT ISSUED PURSUANT TO RULE 7.3 AND VIABILITY STATEMENT ISSUED PURSUANT TO RULE 10.2

To: (Name and Address of Depositor or Attorney)

Human Genome Sciences, Inc.
Attention: Robert H. Benson
9410 Key West Avenue
Rockville, MD 20850

Deposited on Behalf of: Human Genome Sciences, Inc. - Docket No. PF206 and PF207

Identification Reference by Depositor:

ATCC Designation

DNA Plasmid, 172587
DNA Plasmid, 693339

97165
97166

The deposits were accompanied by: ☐ a scientific description ☐ a proposed taxonomic description indicated above.

The deposits were received May 26, 1995 by this International Depository Authority and have been accepted.

AT YOUR REQUEST:

☒ We will inform you of requests for the strains for 30 years.

The strains will be made available if a patent office signatory to the Budapest Treaty certifies one's right to receive, or if a U.S. Patent is issued citing the strains and ATCC is instructed by the United States Patent & Trademark Office or the depositor to release said strain.

If the cultures should die or be destroyed during the effective term of the deposit, it shall be your responsibility to replace them with living cultures of the same.

The strains will be maintained for a period of at least 30 years after the date of deposit, and for a period of at least five years after the most recent request for a sample. The United States and many other countries are signatory to the Budapest Treaty.

The viability of the cultures cited above was tested June 6, 1995. On that date, the cultures were viable.

International Depository Authority: American Type Culture Collection, Rockville, Md. 20852 USA

Signature of person having authority to represent ATCC:


Annette L. Bade, Director, Patent Depository

Date: June 6, 1995

cc: Greg D. Ferraro, J.D.